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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,692	03/27/2006	Pascale Lacan	ESSR:111US/10603706	7189
32425	7590	01/06/2011	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			ROBINSON, ELIZABETH A	
			ART UNIT	PAPER NUMBER
			1787	
			NOTIFICATION DATE	DELIVERY MODE
			01/06/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

aopatent@fulbright.com

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/573,692	LACAN ET AL.
	Examiner	Art Unit
	Elizabeth Robinson	1787

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 November 2010.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19-34,36-45 and 47 is/are pending in the application.  
 4a) Of the above claim(s) 23,24 and 44 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19-22,25-34,36-43,45 and 47 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-22, 25-34, 36-43, 45 and 47 are currently being examined.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 19, 2010 has been entered.

### ***Claim Rejections - 35 USC § 112***

**Claim 45 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

It is unclear what the offset is referring to. There is no teaching of what this offset is measured from or if the offset is some sort of rotational or translational movement.

***Claim Rejections - 35 USC § 103***

**Claims 19-21, 33, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlin (US 5,792,537) in view of Hage (US 2004/0087680).**

Regarding claims 19-21, Ohlin teaches an optical lens, such as a progressive lens, with a marking formed from a removable ink (protective coating that has an outer layer that is mechanically alterable through friction and/or contact) formed on the lens surface and then covered with a removable mask (Ohlin, claim 1). The mask can cover a center portion of the lens (Figure3). The preferred material for the mask is a static cling vinyl (Column 6, lines 33-45).

Ohlin does not teach the composition of the marking ink.

Hage (Paragraphs 7-15) teaches an ophthalmic lens marking ink for lenses, such as progressive lenses, that is easy to remove and does not result in a ghost image after removal. The lens marking ink comprises a pigment (Paragraph 24) and the preferred pigment is titanium dioxide. Titanium dioxide is a mineral and a metal oxide.

It would be obvious to one of ordinary skill in the art to use the marking ink of Hage, as the marking ink of Ohlin, in order to have a marking ink that is easy to remove and does not cause a ghost image after removal.

Regarding claims 33, 34 and 36, Ohlin (Column 6, lines 33-45) teaches that the plastic material film is preferably a polyvinyl chloride film that contains 49 to 57 percent plasticizer.

**Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlin (US 5,792,537) in view of Hage (US 2004/0087680) as applied to claim 19 above, and further in view of Mascarenhas et al. (US 5,888,615).**

Regarding claim 37, as stated above, Ohlin, using the marking ink of Hage, teaches a lens that meets the limitations of claim 19 and states that it is preferred that the plastic material film is a polyvinyl chloride cling film.

Ohlin does not explicitly state the thickness of the film.

Mascarenhas (Column 2, lines 1-15) teaches that most cling films are vinyl chloride films that comprise 50-55 weight % plasticizer and have thicknesses from about 0.004 to 0.014 inches (101 to 355 microns).

The thickness of the film of Ohlin either meets the thickness limitation of the instant claim, since this is a standard thickness for these sheets or it would be obvious to one of ordinary skill in the art to use a film with a thickness that has been shown to be effective for cling films as taught by Mascarenhas.

**Claims 19-22, 25-32, 38-43, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641) in view of Lipman (US 5,451,281).**

Regarding claims 19-22, 25, 26 and 47, Conte (Page 3, line 29 through Page 4, line 6) teaches an ophthalmic lens comprising a temporary protective layer. The temporary protective coating can be formed on both the concave and convex sides of the lens (Page 10, lines 6-19). The temporary protective layer can be formed from

$MgF_2$  (Page 6, lines 16-24). The temporary protective layer can be removed by dry wiping (Page 10, lines 25-29). For the trimming (edging) operation, the temporary protective layer on the convex side of the lens is present in order to contact the self adhesive chip or double sided adhesive attached to a lens holding means (Page 8, lines 18-34).

Conte does not teach coating the protective layer with a peelable film.

Lipman (Column 2, lines 49-66 and Figures 1-4) teaches a protective film 1 that imparts scratch resistance to a lens during the edging operation. The protective film 1 (Column 4, lines 37-68) can be a film with cling properties (electrostatically adhering). This film is releasably adhered to the lens (Column 6, lines 15-33) and thus, is peelable. The concave surface of the lens can be completely covered with the film material (Column 6, lines 56-59). This would cover the central part of the concave surface of the lens.

It would be obvious to one of ordinary skill in the art to use the protective film of Lipman, over the concave surface of the coated lens of Conte, in order to ensure that the surface of the lens is protected during the edging operation.

Regarding claim 27, Conte (Page 6, lines 3-5) teaches that the inorganic (mineral) protective layer has a preferable thickness of 5 to 200 nm.

Regarding claim 28, Conte (Page 8, lines 31-34) teaches that the protective layer has a surface energy of at least 15 mJoules/m<sup>2</sup>.

Regarding claims 29 and 30, Conte (Page 6, lines 1 and 2) teaches that the protective layer is preferably continuous. Further as shown in Example 1, the entire lens surface is coated with the protective layer.

Regarding claim 31, Conte (Page 6, lines 32 and 33) teaches that the temporary protective layer can have multiple layers.

Regarding claim 32, Conte (Page 7, lines 20-22) teaches that the protective layer can be formed by vapor phase deposition.

Regarding claim 38, Conte (Page 6, lines 16-19) teaches that the protective layer is coated on a hydrophobic and/or oleophobic surface coating.

Regarding claims 39 and 40, Conte (Page 4, lines 29-34) teaches that the hydrophobic and/or oleophobic surface coating preferable has a surface energy lower than 12 mJoules/m<sup>2</sup>.

Regarding claims 41 and 42, Conte (Page 5, lines 17-22) teaches that the hydrophobic and/or oleophobic surface coating preferably has a thickness from 2 to 5 nm.

Regarding claim 43, Conte (Page 4, line 25-28) teaches that the hydrophobic and/or oleophobic surface coating is generally applied to lenses comprising an antireflecting coating.

Regarding claim 45, the temporary protective coating of Conte can be formed of the same materials and in the same manner as in the instant application. As stated above, the temporary protective layer provides good adherence of the convex side of the lens to the lens holding pad during the trimming (edging) operation. Since the

temporary protective coating of Conte can be the same as that of the instant application and provides the same adherence during edging, the lens of Conte would undergo the same offset as in the instant application and meet the offset limitation.

**Claims 19-22, 25-34, 36-43, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641) in view of Spector et al. (US 5,883,169).**

Regarding claims 19-22, 25, 26 and 47, Conte (Page 3, line 29 through Page 4, line 6) teaches an ophthalmic lens comprising a temporary protective layer. The temporary protective layer can be formed from  $MgF_2$  (Page 6, lines 16-24). The temporary protective layer can be removed by dry wiping (Page 10, lines 25-29).

Conte does not teach coating the protective layer with a peelable film.

Spector (Column 8, lines 33-62) teaches a removable film that can be used on any plastic lens and can provide abrasion protection to the lens during shipment and storage. The film is not crosslinked to the lens surface (Column 2, lines 30-36) and can generate static charge when peeled (Column 7, lines 35-46). Thus, the adhesion has some degree of electrostatic adhesion.

It would be obvious to one of ordinary skill in the art to add the abrasion protection film of Spector, to the treated lens of Conte, in order to protect the lens surface from abrasion during shipment and storage of the lens. The film would protect the whole surface of the lens and would cover the center of the lens.

Regarding claim 27, Conte (Page 6, lines 3-5) teaches that the inorganic (mineral) protective layer has a preferable thickness of 5 to 200 nm.

Regarding claim 28, Conte (Page 8, lines 31-34) teaches that the protective layer has a surface energy of at least 15 mJoules/m<sup>2</sup>.

Regarding claims 29 and 30, Conte (Page 6, lines 1 and 2) teaches that the protective layer is preferably continuous. Further as shown in Example 1, the entire lens surface is coated with the protective layer.

Regarding claim 31, Conte (Page 6, lines 32 and 33) teaches that the temporary protective layer can have multiple layers.

Regarding claim 32, Conte (Page 7, lines 20-22) teaches that the protective layer can be formed by vapor phase deposition.

Regarding claims 33, 34 and 36, Spector (Column 7, lines 14-34) teaches that the film can be formed from a vinyl chloride copolymer with flexibility that can comprise about 20 to about 30% by weight of a plasticizer.

Regarding claim 37, Spector (Column 8, lines 8-15) teaches that the film preferably has a thickness of about 8 to 50 microns, but that a thicker film will afford greater abrasion resistance.

Conte in view of Spector does not teach a thickness of 100 to 200 microns.

However, since the instant specification is silent to unexpected results, the thickness of 100 to 200 microns is not considered to confer patentability to the claims. As abrasion resistance is a variable that can be modified, among others, by adjusting the thickness of the layer, the precise thickness would have been considered

a result effective variable by one having ordinary skill in the art at the time the invention was made. As such, without showing unexpected results, the claimed thickness cannot be considered critical. Accordingly, one of ordinary skill in the art at the time the invention was made would have optimized, by routine experimentation, the thickness of the film of Spector, that protects the lens of Conte, to obtain the desired abrasion resistance (*In re Boesch*, 617 F.2d. 272, 205 USPQ 215 (CCPA 1980)), since it has been held that where the general conditions of the claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. (*In re Aller*, 105 USPQ 223).

Regarding claim 38, Conte (Page 6, lines 16-19) teaches that the protective layer is coated on a hydrophobic and/or oleophobic surface coating.

Regarding claims 39 and 40, Conte (Page 4, lines 29-34) teaches that the hydrophobic and/or oleophobic surface coating preferable has a surface energy lower than 12 mJoules/m<sup>2</sup>.

Regarding claims 41 and 42, Conte (Page 5, lines 17-22) teaches that the hydrophobic and/or oleophobic surface coating preferably has a thickness from 2 to 5 nm.

Regarding claim 43, Conte (Page 4, line 25-28) teaches that the hydrophobic and/or oleophobic surface coating is generally applied to lenses comprising an antireflecting coating.

Regarding claim 45, the film of Spector (Column 8, lines 33-62) can be removed prior to subsequent forming operations. This would expose the temporary protective

layer of Conte. For the trimming (edging) operation, the temporary protective layer on the convex side of the lens is present in order to contact the self adhesive chip or double sided adhesive attached to a lens holding means (Page 8, lines 18-34). The temporary protective coating of Conte can be formed of the same materials and in the same manner as in the instant application. As stated above, the temporary protective layer provides good adherence of the convex side of the lens to the lens holding pad during the trimming (edging) operation. Since the temporary protective coating of Conte can be the same as that of the instant application and provides the same adherence during edging, the lens of Conte would undergo the same offset as in the instant application and meet the offset limitation.

### ***Response to Arguments***

Applicant's arguments filed November 19, 2010 have been fully considered but they are not persuasive.

Applicant argues that the term "offset" is not indefinite and cites a number of U.S. patents that have issued with the terms "offset" and "lens" in the claims. However, the presence of these terms in the claim language does not lead to the conclusion that the terminology is used in the same manner as in the instant application. For example, in claim 11 of Bhalakia et al. (US 5,827,614), the term offset was used to discuss relative positions of focal surfaces of the lens. There were numerous other examples of other uses for the term offset in patents for lenses in a brief search conducted by the Examiner.

Applicant further argues that there is an ISO standard for measuring the offset parameter and provides a PCT publication and U.S. patent application publication that discuss the term offset. However, it is noted that both publications are dated later than the priority date of the instant application and thus, do not necessarily show the state of the art at the time the application was filed. Further, the discussion in the first paragraph of page 37 of the cited PCT publication states that the axis was measured according to the ISO standard to arrive at the value of the offset. Since the cited ISO standard was not provided, it is unclear if it teaches the offset parameter or just how to measure the axis and further it is unclear if it is dated prior to Applicant's priority date.

Due to amendment of claim 19 removing the terminology, "amount that provides sufficient adhesion of the lens to a holding pad", the 35 U.S.C. 112, second paragraph rejections over that terminology are withdrawn.

Since the terminology added to claim 19 is that the peelable film covers the central part of the surface of the lens, instead of that of former claim 46, that it covered the center part of the temporary coating, there is no indefiniteness rejection presented over claim 19.

Due to amendments to claim 19 requiring a mineral outermost coating, the rejections over Ohlin (US 5,792,537), from the August 19, 2010 Office Action, are withdrawn and replaced with those presented above over Ohlin in view of Hage (US 2004/0087680).

The rejections over Conte et al. (WO 03/057641) in view of Lipman (US 5,451,281) from the August 19, 2010 Office Action are withdrawn and replaced with

those presented above. Applicant's arguments over whether the central portion of the film of Lipman is present are moot, since the rejection is now over the film on the opposite side of the lens, which does not have the center hole for the acorn.

Applicant argues that the examiner did not provide sufficient consideration to the Declaration filed May 21, 2010 and cites section 716.01(c)(III) of the MPEP. However, the Examiner did consider the declaration, but did not find it persuasive to overcome the rejection of record. The declaration only provided an opinion that more protection is not needed, but provided no factual basis to support this opinion. Since Applicant has not provided data to show that the additional protection of Lipman would provide no benefit, only an opinion that this protection is not needed, the Examiner maintains that the burden of proof remains with Applicant to show that the additional protection of Lipman would provide no additional benefit.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, it is the examiner's position that the rejection is not based on hindsight but rather on motivation to combine found in Lipman itself. Thus, the combination of Conte with Lipman would have been obvious to one of ordinary skill in the art. It is

because the rejection is based on motivation found in Lipman, and not on the examiner's own opinion based on facts within the examiner's personal knowledge, that it is not required that the examiner provide some form of evidence or declaration under 37 CFR 1.104(d)(2) as set forth on page 13 of the amendment.

Applicant makes note of a previous discussion of damage during edging versus transportation and storage. The Examiner realizes that different stresses are applied at different phases of lens processing, but also notes that edging requires abrasive grinding and thus, would provide somewhat high stress to the lens surface.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Robinson whose telephone number is (571)272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. R./  
Elizabeth Robinson  
Examiner, Art Unit 1787

December 22, 2010

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1787